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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,258	09/19/2003	Donald E. Godshaw	04286.00136	1148

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EXAMINER

PICKETT, JOHN G

ART UNIT PAPER NUMBER

3728

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,258

Applicant(s)

GODSHAW ET AL. 

Examiner

Gregory Pickett

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lark (US 6,325,077) in view of Margerum (US 3,904,003) and Zipper (US 3,777,862).

Regarding claim 1, Lark discloses a cosmetic and utility kit 10 with a generally rectangular parallelepiped container 11 with an open top 14, an elongated flexible material bottom extension panel 17 & 18, and an elongated top flap extension panel 13 & 15.

Lark lacks the express disclosure of a fabric material, a bottom extension panel that also extends over the open top, and a single elongated fastener.

As to the material, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the kit of Lark in a fabric material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

As to the bottom extension panel that also extends over the open top, Margerum discloses an extension panel 16a & 62 with an additional storage compartment 70 that extends over the open top of the container 12 (see Figures 3 & 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the kit of Lark with an additional storage compartment as taught by Margerum for the obvious reason of additional storage capacity.

As to the single elongated fastener, Zipper discloses a single elongated fastener 102. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the kit of Lark-Margerum with an elongated fastener as taught by Zipper in order to seal the compartment from external debris.

Regarding claim 2, the kit of Lark-Margerum-Zipper discloses a fastener that is a zipper (Zipper, 102).

2. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lark-Margerum-Zipper as applied to claim 1 above, and further in view of Belenson (US 4,210,186).

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Lark-Margerum-Zipper as applied to claim 1 above discloses the claimed invention except for the storage pockets on the end panels with a zipper closure.

Belenson discloses a bag 10 with additional storage compartments 11 & 12 on the end panels of the bag and having zipper closures 15 & 16. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the kit of Lark-Margerum-Zipper with end compartments as taught by Belenson for the obvious reason of additional storage capacity.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 and 2 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of U.S. Patent No. 6,681,936. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variants on claim 5 of US 6,681,936.

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Claim 1 merely removes the mirror or tray requirements of claim 5 of US 6,681,936. It would have been obvious to one having ordinary skill in the art at the time the invention was made to remove the mirror or tray, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same function as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

As to claim 2, the specification of US 6,681,936 defines the peripheral fastener as a zipper.

4. Claims 3-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 & 8 of U.S. Patent No. 6,681,936 in view of Zipper (US 3,777,862).

Regarding claims 3 and 4, claims 7 and 8 of US 6,681,936 disclose the claimed invention except for the peripheral fastener.

Zipper discloses a peripheral fastener. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the kit of US 6,681,936 with an elongated fastener as taught by Zipper in order to seal the compartment from external debris.

As to claim 5, the specification of US 6,681,936 defines the end pockets as claimed.


Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
21 November 2004



Mickey Yu
Supervisory Patent Examiner
Group 3700